



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER 09/309,139	FILING DATE 07/02/98	FIRST NAMED APPLICANT FAYLOR	ATTORNEY DOCKET NO. J
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H01 2/0319

EXAMINER

ROBINSON, A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/19/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

3/19/99

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 2-16-99

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 7, 9 and 11-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 7, 9 and 11-18 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "alkynl" (line 3 after the second structural formula) is indefinite as to what is intended.

Claims 11-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific inorganic salts of phosphonate and phosphate compounds, does not reasonably provide enablement for all the salts of phosphonate and phosphate compounds. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The limited number of examples of inorganic phosphonate and phosphate compounds in the specification will obviously not support all phosphate and phosphonate compounds as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7, 9 and 11-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 9, 13 and 15 of copending Application No. 08/943,002. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's proffer of a Terminal Disclaimer is noted.

Claims 7, 9 and 11-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10, 12, 16 and 18 of copending Application No. 08/943,002. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method claims in the copending application use the claimed compositions..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's proffer of a Terminal Disclaimer is noted.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 9 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 9 of copending Application No. 08/943,002. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barlet (A), Ducret et al. (B), Horriere et al. (C), Lovatt (D) and Vetanovetz et al. (E), all of record and for reasons of record as set forth in paper number 3, pages 4 and 5, regarding the rejection of claims 7-9 and 11-19. Applicant's arguments have been carefully considered; however, they are not deemed persuasive. The data in the specification is noted, but does not show unexpected and/or unobvious results for all the pathogens, all the broad ranges and for all the compounds claimed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen J. Robinson whose telephone number is (703) 308-4524.

AJR
March 17, 1999


ALLEN J. ROBINSON
PRIMARY EXAMINER
CRNIP1200